

## REMARKS

The present amendment is submitted in response to the Office Action dated October 5, 2010, which set a three-month period for response, making this amendment due by January 5, 2011.

Claims 1, 2, 4 and 7-12 are pending in this application.

In the Office Action, claims 1-4 and 7-12 were rejected under 35 U.S.C. 112, first paragraph, as being failing to comply with the written description requirement and for lack of enablement. Claims 1-4 and 7-12 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement and the written description requirement. Claims 1-4 and 7-12 were further rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-4 and 7-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over US 2,253,195 to Oster.

Turning first to the objection to the specification, the prior amendment to page 6 has been corrected.

Regarding the rejection of the claims for lack of enablement and as failing to comply with the written description requirement, specifically with regard to the adjusting element, claim 1 has been amended to include wording from page 4, second paragraph, of the specification. Claim 1 as amended now positively recites an "oscillation direction" of the cutting blade and that the upper and lower shearing blades move relative to the cutting blade in a direction perpendicular to the oscillation direction. This direction corresponds to the direction of the arrow 32 in the figures.

This clarifying language also more clearly define the invention of the Oster device, which fails to disclose or suggest a hair length cut adjuster as defined in claim 1.

Regarding the objection to the feature of the lack of “contact-pressure force”, the Applicant respectfully submits that it is part of the common general knowledge of mechanical engineers that the force between two surfaces creates a contact-pressure and thereby results in friction. As explained previously, in the present invention, the lateral movement is achieved without contact-pressure **force** and that therefore, there is low friction. To the practitioner, this clearly means that the meaning of contact-pressure force must be the absence of pressure perpendicular to the plane of the blade when moving it. This also corresponds with what is clearly shown regarding the movement in the drawings.

Claim 12 has been amended accordingly to clarify the above meaning.

The Applicant directs the Examiner's attention to the paragraph bridging pages 3-4, which provides:

*The cutting blade 5 is made from a thin flat material 7, preferably from a hard metal sheet 7.1, which leads to an extreme reduction in mass and can furthermore be manufactured economically. The cutting blade 5 is preferably provided with a material thickness S of approximately 0.1 to 1.0 mm. Since the low-mass cutting blade 5 is moreover driven without contact-pressure force, substantially less driving energy is necessary, and interfering vibration at the housing 17 of the hair cutting machine 4 is largely suppressed. Because the low-mass cutting blade 5 is moreover driven without contact- pressure force, extremely low friction results, and thus the oil consumption is extremely low.*

Withdrawal of the rejections under Section 12, first paragraph, is again respectfully requested, since it is submitted that the objected-to features are described adequately and specifically in the specification.

The claims were amended to address the rejection under Section 112, second paragraph.

Turning now to the substantive rejection of the claims, while the Applicants agree that Oster shows some structural feature of the present invention, but certainly does not disclose every feature of the invention as claimed.

***Oster does not provide or suggest:***

1) a hair length cut adjuster with the features of amended claim 1;  
2) a flat material from which the cutting blade is made. Here, the Applicants again note the ribs 14 of what would be the cutting blade in Oster which fit into grooves 18 of the upper and lower shearing blade of Oster.

3) the specific features of the cutting blade, namely, that it is made of a hard metal, that it has a defined thickness of 0.1 to 1 mm and that it has a parallel guide.

The figures in the Oster reference clearly show that the thickness of the blade oscillating between the two fixedly provided parts with serrations must have a substantive thickness in order to allow the grooves and the tongue design (see for example the tongue 14 and grooves 14 of Fig. 3 of Oster).

The cutting blade of the present invention is too thin to provide for guiding grooves and tongues formed in it. In contrast, Oster requires these grooves and

tongues in order to ensure that the blade oscillating between the fixed portions is guided into a lateral oscillation.

Furthermore, in Oster, the rotation of the pin 6 with the eccentric portion 8 of Oster will create a normal force between the blade and the fixedly surrounding portions, which is in contract to the requirement to not create contact-pressure forces. This force is worsened with the groove and tongue design of Oster due to more surface space. Oster therefore teaches away from the thin cutting blade of the present invention.

The Applicants wish for the Examiner to notice a very key difference between the invention and the Oster device: Oster discloses an electric shaver, which must cut rigid and very short hairs, while the present invention relates to a cutting device that cuts fairly long hair on an individual's head.

The Applicants therefore submit that the invention is not obvious over Oster, since Oster actually teaches away from the invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

Further, the Applicants submit that the combination of the features that make up the present invention were not suggested or disclosed by any of the art available at the time of the invention. The Examiner cannot merely allege that the features are "old and well-known" and therefore would have ben obvious for including in the Oster device. Pursuant to the guidelines set forth in **KSR**, the Examiner he must clearly articulate why the claimed invention would have been

obvious, and he cannot make "mere conclusory statements"; his analysis must be "explicit".

The application in its amended state is believed to be in condition for allowance. Action to this end is courteously solicited. Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "M. Striker", with a long horizontal flourish extending to the right.

Michael J. Striker  
Attorney for Applicant  
Reg. No.: 27233  
103 East Neck Road  
Huntington, New York 11743  
631-549-4700